

Serial No.: 10/010,158
Practitioner Docket No. 019502.0007US1

REMARKS

35 USC § 112

Claim 1 is rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Applicant respectfully disagrees, but has herein amended claim 1 to use the language that the Examiner recommended.

The phrase "resiliently connected" herein replaces the term "biased". Although the Applicant maintains that the phrase "the first and second arms are biased" clearly means that there is an external force pushing the first and second arms away from one another, such that when someone presses on the first and second arms – forcing them together – and then releases the first and second arms, the first and second arms "spring" back to their original position., and that this "springing" back to the original position would not be possible without some external force on the first and second arms, the Applicant has herein amended claim 1.

The Applicant, through his undersigned Attorney-of-Record respectfully requests a teleconference with the Examiner, if this rejection is not removed by this response. If a teleconference is not scheduled between the undersigned Attorney-of-Record and the Examiner to resolve this aspect of the present application before the three-month deadline, the Applicant will file a Notice of Appeal before the three-month deadline of December 11, 2002 in order to avoid additional and unnecessary charges and fees to the Applicant.

Serial No.: 10/010,158
Practitioner Docket No. 019502.0007US1

35 USC §102

Claims 1 and 6 are herein rejected under 35 USC §102(b) as being anticipated by Chen (US DES 276,786). The Applicant respectfully maintains his disagreement.

Claim 1 recites in part "A bag slitting apparatus for opening a sealed bag along an edge of said bag,...wherein the other of said inner surfaces has a transverse laterally-open concave groove there across for receiving therein the blade tip and a continuously moving bag edge there across for receiving therein the blade tip and a continuously moving bag edge..." (emphasis added). Claim 1 further recites that the first and second arms are "resiliently connected". (emphasis added)

Chen teaches the ornamental design for a plastic bag opener, substantially as shown and described in the Design Patent at issue. The Chen design clearly shows a convex surface that is directly opposite of the blade tip. Chen does not discuss or teach that a transverse laterally-open concave groove is or can be present in the ornamental design contemplated by Chen. Furthermore, as mentioned in earlier correspondence with the Examiner (Preliminary Amendment dated 11/13/2001), in the present application, the laterally-open groove permits continuous passage and slitting of a bag edge, whereas in Chen the second inner surface has a non-laterally-open walled hole for receiving the sharp projection – which appears to function as a punch – and consequently would not allow continuous movement for slitting a bag edge. Therefore, among other reasons, Chen does not disclose the claimed invention, which contains in part that there is a transverse laterally-open concave groove there across for receiving therein the blade tip. Further, after a fair review of the Chen Ornamental Design, one with ordinary skill in the art of opening and bag opening device design and assembly would not consider designing and using a transverse laterally-open concave groove there across for receiving therein the blade tip. Also, Chen clearly does not teach that the first or second arms are "resiliently connected". The Applicant has taken the liberty of reproducing the Chen Ornamental Design, along with the apparatus contemplated in the present application, below. From the side-by-side comparison of the Chen Ornamental Design and the Votolato apparatus, it is clear that Chen does not anticipate the Votolato apparatus of the present application.

Serial No.: 10/010,158
Practitioner Docket No. 019502.0007US1

In addition, the Chen Ornamental Design does not teach all of the claimed elements of the present application. "Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundscriber Corp. v. United States*, 360 F.2d 954, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)) Further, the prior art reference must disclose each element of the claimed invention "arranged as in the claim". *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). The Chen Ornamental Design does not teach a transverse laterally-open concave groove there across for receiving therein the blade tip and the Chen Ornamental design certainly does not teach that the first and second arms are "resiliently connected". Claim 1 is therefore allowable as not being anticipated by the Chen Ornamental Design. Further, the Chen Ornamental Design does not anticipate claim 6 of the present application by virtue of its dependency on claim 1.

35 USC §103

Claims 2-5 are herein rejected under 35 USC §103(a) as being unpatentable over Chen (US DES 276,786) in view of Gilman (US 4,581,823). The Applicant respectfully maintains his disagreement.

The following is a quotation of MPEP 608.01 (n) page 600-70, column 2, paragraph 3:

"Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. *It is this combination that must be compared to the prior art, exactly as if it were presented as one independent claim.*" (Emphasis added).

In re Frisch reiterates MPEP § 608.01 (n) by stating that:

Serial No.: 10/010,158
Practitioner Docket No. 019502.0007US1

"dependent claims are non-obvious if the independent claims from which they depend are non-obvious...". (972 F.2d 1260, 1266; 23 USPQ2d 1780, 1784 (Fed. Cir. 1992)). (Emphasis added).

Claims 2-5 of the present application are dependent on independent claim 1. Claim 1 is deemed non-obvious, and thus allowable, by the Examiner in Paper No. 3. Therefore, claims 2-5 must be allowable by virtue of their dependency on claim 1.

Aside from the above argument, claim 1 recites in part "A bag slitting apparatus for opening a sealed bag along an edge of said bag,...wherein the other of said inner surfaces has a transverse laterally-open concave groove there across for receiving therein the blade tip and a continuously moving bag edge there across for receiving therein the blade tip and a continuously moving bag edge..." (emphasis added). Claim 1 further recites that the first and second arms are "resiliently connected". (emphasis added)

Chen teaches the ornamental design for a plastic bag opener, substantially as shown and described in the Design Patent at issue. The Chen Ornamental Design clearly shows a **convex surface** that is directly opposite of the blade tip. Chen does not discuss or teach that a transverse laterally-open concave groove is or can be present in the ornamental design contemplated by Chen. Therefore, among other reasons, the Chen Ornamental Design does not disclose the claimed invention, which contains in part that there is a transverse laterally-open concave groove there across for receiving therein the blade tip. Further, after a fair review of the Chen Ornamental Design, one with ordinary skill in the art of opening and bag opening device design and assembly would not consider designing and using a transverse laterally-open concave groove there across for receiving therein the blade tip. Also, the Chen Ornamental Design does not teach, suggest or motivate one of ordinary skill in the art to "resiliently connect" the first and second arms in order to improve the utility of the apparatus. As shown from the diagrams on the previous page, it is abundantly clear that the Chen Ornamental Design and the Votolato Apparatus from the present application are not similar at all in this respect, and the Chen Ornamental Design does not render the Votolato Apparatus in the present application as obvious. And based on this argument, among others, claim 1 of the present application is not obvious in view of Chen. Further, claims 2-5 are not obvious in view of Chen by

Serial No.: 10/010,158
Practitioner Docket No. 019502.0007US1

virtue of their dependency on claim 1.

Gilman teaches a letter opener for cutting open an envelope comprising a channel-based blade holder having a pair of manually-movable arms and a cutting blade mounted on one of the arms. Gilman does not discuss or teach that a transverse laterally-open concave groove is or can be present in the contemplated embodiments of the Gilman patent. Therefore, among other reasons, Gilman does not disclose the claimed invention, which contains in part that there is a transverse laterally-open concave groove there across for receiving therein the blade tip. Further, after a fair review of Gilman, one with ordinary skill in the art of opening and bag opening device design and assembly would not consider designing and using a transverse laterally-open concave groove there across for receiving therein the blade tip. And based on this argument, among others, claim 1 of the present application is not obvious in view of Gilman. Further, claims 2-5 are not obvious in view of Gilman by virtue of their dependency on claim 1.

Finally, with regard to the present rejection, there is no motivation or suggestion to combine or modify the Chen Ornamental Design in view of Gilman, given that Gilman does not discuss or teach that a transverse laterally-open concave groove is or can be present in the contemplated embodiments of the Gilman patent. Gilman also does not discuss or teach that first and second arms or any part of the Gilman apparatus can be resiliently connected. Based on these arguments, among others including those discussed above, claim 1 is allowable as patentable over Chen in view of Gilman. Further, claims 2-5 are allowable as patentable over Chen in view of Gilman by virtue of their dependency on independent claim 1.

REQUEST FOR TELECONFERENCE

The Applicant again respectfully requests a teleconference with the Examiner if all of the issues are not resolved and the application not placed in condition for allowance upon review of this Response. The undersigned Attorney-of-Record can be reached on behalf of the Application at the direct line number shown below.

Serial No.: 10/010,158
Practitioner Docket No. 019502.0007US1

NOTICE OF APPEAL

If the Examiner places this application in immediate condition for allowance, the Applicant respectfully requests that the Examiner notify the Applicant immediately through his undersigned Attorney-of-Record.

The Applicant has now respectfully requested a teleconference with the Examiner twice by asking that if all of the issues are not resolved and the application is not placed in condition for allowance upon review of this and the previously-filed Response that the Examiner contact the undersigned Attorney-of-Record. At this point, the Applicant has made every attempt to request that the Examiner contact the undersigned Attorney-of-Record immediately and by phone or fax in order to quickly resolve the issues left in dispute, in order to place this case in condition for allowance, and in order to remove this case from the docket of the Examiner and the undersigned Attorney-of-Record.

If the Applicant or undersigned Attorney-of-Record does not hear from the Examiner by December 11, 2002 – the three-month deadline for a Response under the original Final Office Action – the Applicant will file a Notice of Appeal with the USPTO in order to minimize the accumulation of unnecessary extension fees and related costs with respect to this application.

Serial No.: 10/010,158
Practitioner Docket No. 019502.0007US1

REQUEST FOR ALLOWANCE

Claims 1-6 are pending in this application. The applicants request allowance of all pending claims.

Respectfully submitted,

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